



INTERNATIONAL TRADE COMMISSION

[Investigation No. 337-TA-1223]

**Certain Shingled Solar Modules, Components Thereof, and Methods for Manufacturing the Same**

**Commission Determination to Review in Part and Remand in Part a Final Initial Determination Finding a Violation of Section 337; Schedule for Filing Written Submissions on Remedy, the Public Interest, and Bonding**

**AGENCY:** U.S. International Trade Commission.

**ACTION:** Notice.

**SUMMARY:** Notice is hereby given that, on October 22, 2021, the presiding acting chief administrative law judge (“ALJ”) issued a combined final initial determination (“ID”) finding a violation of section 337 and a recommended determination (“RD”) on remedy and bonding in the above-captioned investigation. The Commission has determined to review the final ID in part. The Commission has also determined to remand the ID in part to the ALJ to make a determination regarding whether an on-sale bar applies to the asserted claims of U.S. Patent No. 10,651,333 (“the ’333 patent”) based on alleged sales and offers for sale of certain products. The Commission requests briefing from the parties, interested government agencies, and interested persons on the issues of remedy, the public interest, and bonding.

**FOR FURTHER INFORMATION CONTACT:** Richard P. Hadorn, Esq., Office of the General Counsel, U.S. International Trade Commission, 500 E Street, S.W., Washington, D.C. 20436, telephone (202) 205-3179. Copies of non-confidential documents filed in connection with this investigation may be viewed on the Commission’s electronic docket (EDIS) at <https://edis.usitc.gov>. For help accessing EDIS, please email [EDIS3Help@usitc.gov](mailto:EDIS3Help@usitc.gov). General information concerning the Commission may also be obtained by accessing its Internet server at <https://www.usitc.gov>. Hearing-impaired persons are advised that information on this matter can be obtained by contacting the Commission’s TDD terminal, telephone (202) 205-1810.

**SUPPLEMENTARY INFORMATION:** On October 21, 2020, the Commission instituted this

investigation based on a complaint filed by The Solaria Corporation (“Solaria”) of Fremont, California. 85 FR 67010-11 (Oct. 21, 2020). The complaint, as supplemented, alleges violations of section 337 of the Tariff Act of 1930, as amended (19 U.S.C. 1337), based on the importation into the United States, the sale for importation, or the sale within the United States after importation of certain shingled solar modules, components thereof, and methods for manufacturing the same by reason of infringement of certain claims of U.S. Patent Nos. 10,522,707 (“the ’707 patent”); the ’333 patent; and 10,763,388 (“the ’388 patent”). *Id.* at 67011. The complaint further alleges that a domestic industry exists. *Id.* The notice of investigation named two respondents: Canadian Solar Inc. of Guelph, Ontario, Canada and Canadian Solar (USA) Inc. of Walnut Creek, California (collectively, “Canadian Solar”). *Id.* The Office of Unfair Import Investigations is not named as a party. *Id.*

On July 15, 2021, the Commission determined to terminate the investigation as to the ’707 patent based on Solaria’s withdrawal of the allegations in the complaint as to that patent. Order No. 9 (June 28, 2021), *unreviewed by* Comm’n Notice (July 15, 2021). On October 13, 2021, the Commission determined to terminate the investigation as to asserted claims 18-20 of the ’333 patent and asserted claims 6, 7, and 10 of the ’388 patent based on Solaria’s withdrawal of the allegations in the complaint as to those claims. Order No. 13 (Sept. 14, 2021), *unreviewed by* Comm’n Notice (Oct. 13, 2021).

On October 22, 2021, the ALJ issued the subject final ID on violation and RD on remedy and bonding. The ID finds violations of section 337 with respect to all asserted claims still at issue—*i.e.*, asserted claims 1-5, 8, 9, 11, 15-17, 19, and 20 of the ’388 patent and asserted claims 1, 8, 9, and 12-17 of the ’333 patent. Specifically, the ID finds that: (i) Solaria has standing to assert both the ’388 and ’333 patents; (ii) the asserted claims of each patent are infringed and not invalid; (iii) the ’333 patent is not unenforceable due to unclean hands; and (iv) Solaria satisfied the technical and economic prongs of the domestic industry requirement as to both patents. The

RD recommends that, should the Commission determine that violations of section 337 occurred, then the Commission should: (i) issue a limited exclusion order against Canadian Solar's infringing products; (ii) not issue a cease and desist order against Canadian Solar; and (iii) set a 100 percent bond for any importations of infringing products during the period of Presidential review.

On November 5, 2021, Canadian Solar filed a petition for review of the ID on violation, including the ID's findings concerning standing, claim construction, infringement, invalidity, unenforceability, and satisfaction of the technical prong of the domestic industry requirement. On November 15, 2021, Solaria filed a response to Canadian Solar's petition.

On November 22, 2021, Canadian Solar filed a notice of supplemental authority to inform the Commission that a claim construction order issued in a related district court litigation ("district court order") involving the same parties and patents at issue in this investigation.

On November 23, 2021, Canadian Solar filed a submission on the public interest pursuant to Commission Rule 210.50(a)(4) (19 CFR 210.50(a)(4)). The Commission did not receive a public interest submission from Solaria. The Commission also did not receive any submissions on the public interest from members of the public in response to the Commission's *Federal Register* notice. 86 FR 62845-46 (Nov. 12, 2021).

The Commission has determined to review the ID in part and remand the ID in part. Specifically, the Commission has determined to review: (i) the ID's construction of the claim term "ablation" of the '388 and '333 patents in light of the district court order's construction of that term; (ii) the ID's allocation of the burden of proof regarding the asserted claims' entitlement to claim priority to the filing date of U.S. Provisional Application No. 62/349,547 ("the '547 provisional application"); (iii) the ID's finding that claim 19 of the '388 patent and claim 8 of the '333 patent find written description support in the '547 provisional application; (iv) the ID's findings on validity for the '388 patent; and (v) the ID's finding concerning secondary considerations with respect to the '333 patent. The Commission has determined to

remand the ID to the ALJ to address, in the first instance, Canadian Solar's on-sale bar defenses as to the asserted claims of the '333 patent based on alleged sales and offers for sale of Solaria's BIPV and GIPV products. The Commission has also determined to correct one typographical error on page 48 of the ID. The Commission has determined not to review the remaining findings in the ID.

In connection with its review, the Commission requests responses to the following questions. The parties are requested to brief their positions with reference to the applicable law and the existing evidentiary record.

- (1) Explain the proper allocation of burdens in the context of showing a patentee's entitlement to rely on a parent application to avoid prior art. *See* ID at 62 (citing *Tech. Licensing Corp. v. Videotek, Inc.*, 545 F.3d 1316, 1327-28 (Fed. Cir. 2008)).
- (2) Explain whether claim 19 of the '388 patent and claim 8 of the '333 patent find written description support in the '547 provisional application. Provide any citations to the record that support your contention.
- (3) Identify each product-by-process limitation recited in the asserted claims of the '388 patent (*e.g.*, "cut by an ablation from multiple passes of a laser beam") and explain whether each such limitation should be accorded patentable weight in the validity analysis of the claims at issue.

The parties are not to brief other issues on review, which are adequately presented in the parties' existing filings.

In connection with the final disposition of this investigation, the statute authorizes issuance of: (1) an exclusion order that could result in the exclusion of the subject articles from entry into the United States, and/or (2) a cease and desist order that could result in the respondents being required to cease and desist from engaging in unfair acts in the importation and sale of such articles. Accordingly, the Commission is interested in receiving written submissions that address the form of remedy, if any, that should be ordered. If a party seeks

exclusion of an article from entry into the United States for purposes other than entry for consumption, the party should so indicate and provide information establishing that activities involving other types of entry either are adversely affecting it or likely to do so. For background, see *Certain Devices for Connecting Computers via Telephone Lines*, Inv. No. 337-TA-360, USITC Pub. No. 2843, Comm'n Op. at 7-10 (December 1994).

The statute requires the Commission to consider the effects of any remedy upon the public interest. The public interest factors the Commission will consider include the effect that an exclusion order and/or cease and desist order would have on: (1) the public health and welfare; (2) competitive conditions in the U.S. economy; (3) U.S. production of articles that are like or directly competitive with those that are subject to investigation; and (4) U.S. consumers. The Commission is therefore interested in receiving written submissions that address the aforementioned public interest factors in the context of this investigation.

The Commission requests full briefing on the public interest, setting forth a complete and fulsome discussion of whether exclusion of the accused products would have an effect on each public interest factor and providing evidence to substantiate factual assertions. Within the context of the applicable public interest factor, please include particular briefing on the following public interest issues:

- (1) Please identify and describe any planned but not yet completed projects involving the accused products, including the amount (wattage) of accused products needed to complete the project and the anticipated power generation associated with the project.
- (2) Please address the extent to which domestic industry products or other products are technically and practicably capable of replacing the accused products in the planned projects. Please address the extent to which replacing the accused products would result in project delays, additional costs, or reduced power generation.
- (3) To the extent that cancellation, delay, or reduced power generation of a project would result from a remedy in this investigation, how would that impact the overall supply

- of solar and other forms of clean energy in the United States? Please be as specific as possible.
- (4) What is Solaria's and its manufacturing partners' capacity to produce domestic industry products and do they currently have available capacity that could be used to increase production to replace the accused products? To the extent products other than domestic industry products are capable of replacing the accused products, please address the available capacity of any producers to supply those products.
  - (5) What is the relevant market for purposes of considering the public interest in this investigation, for example, the market for shingled solar modules or the broader solar module market? What share of the market do the various market participants hold, including Canadian Solar and Solaria? What market share do domestically-produced solar modules have?
  - (6) Please address whether an exception to any remedial orders for modules and/or parts for warranty, service, or repair obligations is necessary to address any identified public interest concerns. Please identify the scope of any such exception, if any, and any evidence relevant to this issue. Please also address whether Canadian Solar's warranty, service, or repair obligations could be met with non-infringing alternatives.
  - (7) Please address whether Canadian Solar's U.S. inventories of accused products are commercially significant in an appropriate context. Are these inventories sufficient to supply the planned projects identified in response to Question 1?
  - (8) To the extent tailoring is requested of any remedial orders to address one or more public interest concerns, is non-issuance of a cease and desist order (*i.e.*, allowing Canadian Solar to continue to sell infringing U.S. inventories) sufficient to address those concerns?

If the Commission orders some form of remedy, the U.S. Trade Representative, as delegated by the President, has 60 days to approve, disapprove, or take no action on the

Commission's determination. *See* Presidential Memorandum of July 21, 2005. 70 FR 43251 (July 26, 2005). During this period, the subject articles would be entitled to enter the United States under bond, in an amount determined by the Commission and prescribed by the Secretary of the Treasury. The Commission is therefore interested in receiving submissions concerning the amount of the bond that should be imposed if a remedy is ordered.

**WRITTEN SUBMISSIONS:** The parties, interested government agencies, and any other interested parties are invited to file written submissions on the issues of remedy, the public interest, and bonding. Such submissions should include views on the recommended determination by the ALJ on remedy and bonding.

In its initial written submission, Solaria is requested to submit proposed remedial orders for the Commission's consideration. Solaria is further requested to identify the dates the asserted patents expire, to provide the HTSUS subheadings under which the subject articles are imported, and to supply identification information for all known importers of the subject articles. Solaria is additionally requested to identify and explain, from the record, articles that are "components of" the subject articles, and thus covered by the proposed remedial orders, if imported separately from the subject articles.

Initial written submissions, including proposed remedial orders, must be filed no later than close of business on **February 18, 2022**. Reply submissions must be filed no later than the close of business on **March 4, 2022**. No further submissions on any of these issues will be permitted unless otherwise ordered by the Commission.

Persons filing written submissions must file the original document electronically on or before the deadlines stated above. The Commission's paper filing requirements in 19 CFR 210.4(f) are currently waived. 85 FR 15798 (Mar. 19, 2020). Submissions should refer to the investigation number (Inv. No. 337-TA-1223) in a prominent place on the cover page and/or the first page. (*See Handbook for Electronic Filing Procedures, [https://www.usitc.gov/documents/handbook\\_on\\_filing\\_procedures.pdf](https://www.usitc.gov/documents/handbook_on_filing_procedures.pdf)*). Persons with questions

regarding filing should contact the Secretary (202-205-2000).

Any person desiring to submit a document to the Commission in confidence must request confidential treatment by marking each document with a header indicating that the document contains confidential information. This marking will be deemed to satisfy the request procedure set forth in Rules 201.6(b) and 210.5(e)(2) (19 CFR 201.6(b) & 210.5(e)(2)). Documents for which confidential treatment by the Commission is properly sought will be treated accordingly. A redacted non-confidential version of the document must also be filed simultaneously with any confidential filing. All information, including confidential business information and documents for which confidential treatment is properly sought, submitted to the Commission for purposes of this investigation may be disclosed to and used: (i) by the Commission, its employees and Offices, and contract personnel (a) for developing or maintaining the records of this or a related proceeding, or (b) in internal investigations, audits, reviews, and evaluations relating to the programs, personnel, and operations of the Commission including under 5 U.S.C. Appendix 3; or (ii) by U.S. government employees and contract personnel,<sup>[1]</sup> solely for cybersecurity purposes. All contract personnel will sign appropriate nondisclosure agreements. All nonconfidential written submissions will be available for public inspection on EDIS.

The Commission vote for this determination took place on February 4, 2022.

The authority for the Commission's determination is contained in section 337 of the Tariff Act of 1930, as amended (19 U.S.C. 1337), and in Part 210 of the Commission's Rules of Practice and Procedure (19 CFR Part 210).

By order of the Commission.

Issued: February 4, 2022.

**Lisa Barton,**  
*Secretary to the Commission.*

---

<sup>[1]</sup> All contract personnel will sign appropriate nondisclosure agreements.



